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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/616,675

07/10/2003

Daniel Charles Birkestrand

ROC920030150US1

2590

46296 7590 02/28/2007
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EXAMINER

ZHE, MENG YAO

ART UNIT

PAPER NUMBER

2109

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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3 MONTHS

02/28/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/616,675

Applicant(s)

BIRKESTRAND ET AL.

Examiner

MengYao Zhe

Art Unit

2109

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 July 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/10/03, 8/6/03, 3/23/06.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement (IDS) submitted on July 10, 2003 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the Examiner has considered the IDS as to the merits.

Specification

The attempt to incorporate subject matter into this application by reference to U.S. patent application "Apparatus and Method for Providing Metered Capacity of Computer Resources" is ineffective because its serial number and filing date are not listed.

Drawings

Figure 8 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

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Similarly, under the section entitled Brief Description of Drawings, Figure 8 should be noted as prior art.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1 to 24 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The term minimum resource specification was mentioned in the specification without defining what it is and what the specification indicates for each partition.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims(s) 1 to 5, 8 to 11, and 14 to 22 are directed to resource recovery.

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This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring phenomenon) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter of

Claims 1 to 2, 4 to 5, 8, 10, 11, 14 to 17, and 19 to 22 provide for making sure that a temporary resource may be recovered. In other words, it can either be recovered or not recovered, which in the case that it is not recovered, the produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Claims 3, 9, and 18 provide for making sure that the sum of all specifications does not exceed the base resources. Since the sum of all specifications never changes, it remains as it is, making the produced result remains in the abstract and, thus, fails to achieve the required status of having real world value.

Claims 19 to 24 lack necessary physical articles or objects to constitute a machine or a manufacture within the meaning of 35 USC 101. They are clearly not a series of steps

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or acts to be a process nor are they a combination of chemical compounds to be a composition of matter. As such, they fail to fall within a statutory category. They are, at best, functional descriptive material *per se*.

Descriptive material can be characterized as either "functional descriptive material" or "non-functional descriptive material." Both types of "descriptive material" are non-statutory when claimed as descriptive material *per se*, 33 F.3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium, it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994)

Merely claiming non-functional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8 (noting that the claims for an algorithm in *Benson* were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").

The claims fail to place the invention squarely within one statutory class of invention.

On page 10, lines 20 to 22 of the instant specification, applicant has provided evidence

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that applicant intends the "medium" to include digital and analog communication links, which are signals. As such, the claim is drawn to a form of energy. Energy is not one of the four categories of invention and therefore this claim(s) is/are not statutory.

Energy is not a series of steps or acts and thus is not a process. Energy is not a physical article or object and as such is not a machine or manufacture. Energy is not a combination of substances and therefore not a composition of matter

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1, 2, 4 to 8, 10 to 17, and 19 to 24 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 7, 10, 11, and 12 of U.S. Patent Application No. 10/616,676 (hereafter 616,676).

Claims 7, 10, 11, 12 of 616,676 teaches a method for providing at least one temporary resource on demand in a computer system that includes

Claims 8, 10: a plurality of logical partitions; *(page 5, claim 7)*

the method comprising the steps of:

Claims 8, 10, 12: enabling the at least one temporary resource; *(page 5, claim 11: the resource allocator does the enabling)*

Claims 8, 10: controlling access to a minimum resource specification for each of the plurality of logical partitions to assure the at least one temporary resource may be recovered when the specified resource-time expires *(The Examiner has interpreted the minimum resource specification as the amount of resources allowed to be used for each of the partition. Claim 12 discloses a resource allocator that can recover temporary resources when the time expires. It is inherent that in order to do so, the minimum resource has to be tracked so that the temporary resources can be differentiated from the minimum resources and can therefore be recovered when the time for the temporary resource expires.)*

Claim 10: requesting an enablement code *(page 5, claim 10)*

Claim 10: receiving the enablement code *(claim 10)*

Claim 11: evaluating an enablement code to determine whether the code is valid, wherein the enablement code includes the specified resource-time.

(claim 10)

Claim 13: recovering the at least one temporary resource when the specified resource-time expires. *(claim 12)*

As per **claim 1**, claim 7 of 616,676 teaches an apparatus that contains

a processor

a capacity manager that has the full capability to perform the methods of claim 8, since claim 8 is rejected, claim 1 is rejected as well.

As per **claim 2**, claim 7 of 616,676 teaches **a capacity manger that resides in a partition manager that manages the plurality of logical partitions.** *(616,676 teaches a capacity manger residing the memory, which is the equivalent of the partition manager that also resides in memory.)*

As per **claim 4**, it contains all the components of claims 1 to 2. Since claims 1 and 2 are rejected, claim 4 is rejected as well.

As per **claim 5**, the apparatus contains all the components to perform the method of claim 11. Since claim 11 is rejected, claim 5 is rejected as well.

As per **claim 6**, the apparatus contains all the components to perform the methods of claim 12. Since claim 12 is rejected, claim 6 is rejected as well.

As per **claim 7**, the apparatus contains all the components to perform the methods of claim 13. Since claim 13 is rejected, claim 7 is rejected as well.

As per **claim 14**, the program product contains all the instruction needed to perform the methods of claim 8. Since claim 8 is rejected, claim 14 is rejected as well.

As per **claim 15**, claim 37 of 616,676 teaches a **signal bearing media comprising recordable media**.

As per **claim 16**, claim 38 of 616,676 teaches a **signal bearing media comprising transmission media**.

As per **claim 17**, it contains all the components of claim 2. Since claim 2 is rejected, claim 17 is rejected as well.

As per **claim 19**, it contains all the instructions to perform the methods of claim 10. Since claim 10 is rejected, claim 19 is rejected as well.

As per **claim 20**, it contains the same component as claim 15. Since claim 15 is rejected, claim 20 is rejected as well.

As per **claim 21**, it contains the same component as claim 16. Since claim 16 is rejected, claim 21 is rejected as well.

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As per **claim 22**, in contains all the instructions to perform the methods of claim 11.

Since claim 11 is rejected, claim 22 is rejected as well.

As per **claim 23**, in contains all the instructions to perform the methods of claim 12.

Since claim 12 is rejected, claim 23 is rejected as well.

As per **claim 24**, in contains all the instructions to perform the methods of claim 13.

Since claim 13 is rejected, claim 24 is rejected as well.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459

(1966), that are applied for establishing a background for determining obviousness

under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1 to 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Camble et al., Publication No. US2003/0135580A1 (hereafter Camble) in view of Circenis et al., Patent Number US7,146,492B2 (hereafter Circenis).

Camble teaches a method for providing at least one temporary resource on demand in a computer system that includes

Claims 8, 9, 10: a plurality of logical partitions; *(Figure 1)*

the method comprising the steps of:

Claims 8, 9, 10, 12: enabling the at least one temporary resource;

(paragraph 14)

Claims 8, 9, 10: controlling access to a minimum resource specification

(paragraph 26; The Examiner has interpreted the minimum resource specification

as the amount of resources allowed to be used for each of the partitions. Camble discloses a management card that checks to make sure that the amount of resources in all partitions does not exceed the allowable sum.)

Claim 9: not allowing a sum of all the minimum resource specifications for all of the plurality of logical partitions to exceed a total of base resources in the computer system. *(paragraph 26; The Examiner notes that Camble discloses a license key that keep track the total amount of resources that the user is allowed to use. This is taken as the equivalent of the base resource.)*

Claims 10: requesting an enablement code *(paragraoh 26; The Examiner has interpreted the enablement code as the equivalent of the license key.)*

Claims 10: receiving the enablement code *(paragraph 26)*

As per **claim 1**, Camble teaches an apparatus that contains

a processor *(113, Figure 1; library controller)*

a capacity manager *(the equivalent of the programmed RMC; 112, Figure 1)*

that has the full capability to perform the methods of claim 8.

As per **claim 2**, Camble teaches **a capacity manger that resides in a partition manager that manages the plurality of logical partitions.** *(paragraph 26; The Examiner notes that RMC 112 of Figure 1 acts as the capacity manager.)*

As per claim 14, Camble also teaches a **computer readable signal bearing media** *(112, Figure 1; the equivalent of RMC).* Claim 14 otherwise includes the same limitations as claim 8.

As per **claim 15**, Camble teaches **a signal bearing media comprising recordable media** *(it is the equivalent of tape drive 103, Figure 1.).*

As per **claim 16**, Camble teaches **a signal bearing media comprising transmission media** *(it is the equivalent of the LAN that is part of RMC 112 in Figure 1.).*

Camble does not teach

Claim 8, 9, 13: assuring the at least one temporary resource be recovered when the specified resource-time expires.

Claims 11: the enablement code include the specified resource-time

However, Circenis does teach:

Claim 8, 9, 13: assuring the at least one temporary resource may be recovered when a specified resource-time expires for the purpose of preventing the user from enjoying permanent enablement of temporary resources without paying for the manufacturer for those resources. (*column 6, lines 40 to 45; column 7, lines 5 to 15; Circenis discloses a system that constantly keep track of temporary capacity balance so that in the event of its expiration, they may be deactivated, thus guaranteeing a full recovery. The Examiner has interpreted the temporary capacity balance as the equivalent of keeping track of the expiration time since the system is capable of tracking the amount of time the user has for using the temporary capacity, column 6, lines 53 to 60.*)

Claim 11: a step of evaluating an enablement code to determine whether the code is valid, wherein the enablement code includes the specified resource-time for the purpose of making the user requested resource temporary so that they may be recovered later (*column 12, line 1 to 10*).

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It would have been obvious to one having ordinary skill in the art at the time of the applicant's invention to have modified the invention of Camble with

Claim 8, 9: assuring the at least one temporary resource may be recovered when a specified resource-time expires, as taught by Circenis, because it prevents the user from enjoying permanent enablement of temporary resources without paying for the manufacturer for those resources.

Claim 11: a step of evaluating an enablement code to determine whether the code is valid, wherein the enablement code includes the specified resource-time, as taught by Circenis, because it makes the user requested resource temporary so that they may be recovered later.

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Further regarding claims 3-7, 14 and 17-24, which contain machine or manufacture limitations for the performance of the above method claims:

as per **claim 3**, it contains all the components to perform the methods of claim 9, since claim 9 is rejected, claim 3 is rejected as well;

as per **claim 4**, it contains all the components of claims 1 to 2. Since claims 1 and 2 are rejected, claim 4 is rejected as well;

as per **claim 5**, the apparatus contains all the components to perform the method of claim 11 (since claim 11 is rejected, claim 5 is rejected as well);

as per **claim 6**, the apparatus contains all the components to perform the methods of claim 12 (since claim 12 is rejected, claim 6 is rejected as well);

as per **claim 7**, the apparatus contains all the components to perform the methods of claim 13 (since claim 13 is rejected, claim 7 is rejected as well);

as per **claim 14**, the program product contains all the instruction needed to perform the methods of claim 8;

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as per **claim 17**, it contains all the components of claim 2. Since claim 2 is rejected, claim 17 is rejected as well;

as per **claim 18**, it contains all the instructions to perform the methods of claim 9. Since claim 9 is rejected, claim 18 is rejected as well;

as per **claim 19**, it contains all the instructions to perform the methods of claim 10. Since claim 10 is rejected, claim 19 is rejected as well;

as per **claim 20**, it contains the same component as claim 15. Since claim 15 is rejected, claim 20 is rejected as well;

as per **claim 21**, it contains the same component as claim 16. Since claim 16 is rejected, claim 21 is rejected as well;

as per **claim 22**, in contains all the instructions to perform the methods of claim 11. Since claim 11 is rejected, claim 22 is rejected as well;

as per **claim 23**, in contains all the instructions to perform the methods of claim 12. Since claim 12 is rejected, claim 23 is rejected as well;

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as per **claim 24**, in contains all the instructions to perform the methods of claim 13.

Since claim 13 is rejected, claim 24 is rejected as well.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MengYao Zhe whose telephone number is 571-272-6946. The examiner can normally be reached on Monday Through Friday, 7:30 - 5:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Del Sole can be reached on 571-272-1130. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JOSEPH DEL SOLE
SUPERVISORY PATENT EXAMINER

2/26/07